

REMARKS

In response to the above-identified final Office Action, no claims are amended, no claims are added and no claims are cancelled. Accordingly, claims 1-8 and 10-17 are pending.

The Patent Office rejects claims 1, 4-5, 8-14 and 17 under 35 U.S.C. §102(e) as anticipated by U.S. Patent Application No. 2001-0037821 of Staley ("Staley"). The Patent Office further rejects claims 2, 3, 6, 7 and 15-16 as being obvious over Staley. Reconsideration of the pending claims is respectfully requested in view of the following remarks.

I. 35 U.S.C. §102(e): Rejection of Claims 1, 4-5, 8, 10-14 and 17

The Patent Office rejects claims 1, 4-5, 8-14 and 17 under 35 U.S.C. §102(e) as anticipated by U.S. Patent Application No. 2001-0037821 of Staley ("Staley"). Staley teaches a multi-component polishing and/or cleaning composition wherein the components are mixed at the point-of-use or immediately before delivery to the point-of-use. Staley describes various components that may or may not be used in embodiments of the polishing and/or cleaning compositions. Both components include an abrasive, an oxidizing agent, a catalyst, a film forming agent, a complexing agent, a surfactant, and a stabilizer. See page 2, paragraphs 13 through page 3, paragraph 22.

Independent claim 1 is not anticipated by Staley, because Staley does not describe a method including removing material from a surface of a wafer by chemical mechanical polishing the wafer with a slurry comprising an oxidizing agent and a buffer and monitoring the current required to rotate the wafer as a measure of the material removal endpoint. In the Final Office Action, the Patent Office recognizes that Staley does not expressly recite the complexing agents (page 3, paragraph [00200]) are buffers. Instead the Patent Office suggests buffering characteristics are inherent within the complexing agents because the compounds recited by Staley function as buffers in the present invention. Applicant respectfully submits, in relying on inherency to teach a claimed element the Patent Office must establish that the inherent characteristic necessarily flows from the teachings of the prior art. *Ex part Levy*, 17 USPQ2d 1461 (Bd. Pat. App. & Inter. 1990). As defined in Applicant's specification a buffer is a

compound that may absorb or release hydrogen ions without large changes in pH of the compound to which it has been added. *See* Application at page 7, paragraph [0026]. The Patent Office has not shown the complexing agent necessarily functions to absorb or release hydrogen ions without large changes in pH of the compound to which it is added. Instead the Patent Office states that “Staley teaches that those of skill in the art will recognize the compounds may perform more than one function and may be in the form of a salt, acid or partial salt” (emphasis added). *See* Detailed Action, page 2. The fact that the characteristic may occur is not sufficient to establish inherency. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Thus the Patent Office has not shown Staley expressly or inherently teaches a method including removing material from a surface of a wafer by chemical mechanical polishing the wafer with a slurry comprising an oxidizing agent and a buffer. Thus, for the above stated reasons, claim 1 is not anticipated by Staley.

Claim 4 is not anticipated by Staley, because as previously discussed, a composition suitable for use in a chemical mechanical polish process which includes a buffer is neither expressly nor inherently taught by Staley.

Claims 5, 8 and 10-11 depend from claim 4 and therefore incorporate all the limitations of claim 4. Thus, for at least the reasons stated with respect to claim 4, claims 5, 8, and 10-11 are not anticipated by Staley.

Claim 12 is not anticipated by Staley because Staley does not describe a kit including a buffer. Staley describes complexing agents not buffers and as previously discussed, the Patent Office has not sufficiently shown that a complexing agent necessarily functions as a buffer as used in the application.

Claims 13-14 and 17 depend from claim 12 and therefore contain all the limitations of that claim. Thus, for at least the reasons stated with respect to claim 12, claims 13, 14 and 17 are not anticipated by Staley.

Applicant respectfully requests that the Patent Office withdraw the rejection of claims 1, 4-5, 8, 10-14 and 17 under 35 U.S.C. §102(e).

II. 35 U.S.C. §103(a): Rejection of Claims 2, 3, 6, 7, 15 and 16

The Patent Office rejects claims 2, 3, 6, 7, 15 and 16 as being obvious over Staley. Claims 2-3, 6-7 and 15-16 depend from independent claims 1, 4 and 12 respectively, and therefore contain all the limitations of those claims. Thus, the rejected claims are not *prima facie* obvious over Staley for the reasons given above with respect to claims 1, 4 and 12. The Patent Office determines although Staley does not explicitly recite the complexing agent is a buffer, the Patent Office determines the compound may function as a buffer. As previously discussed, the Patent Office has not shown the complex agent necessarily possesses buffering characteristics as the term is used in the application therefore Applicant's recited buffer is neither expressly or inherently found within Staley. In addition, there is no suggestion in Staley to combine complexing agents as noted by the Patent Office to form a buffer. Thus, for the above stated reasons, claims 2, 3, 6, 7, 15 and 16 are not obvious over Staley. Applicant respectfully requests the Patent Office withdraw the rejection to claims 2, 3, 6, 7, 15 and 16 under 35 U.S.C. §103(a).

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

Respectfully submitted,

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Date: 1/21/05

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I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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1/21/05
Date